

Application No. 09/889,571
Response dated July 19, 2004
Reply to Office Action of April 21, 2004

REMARKS

Claims 1-12 and 19-51 are pending in this application, of which claims 1-6 have been amended, and claims 19-51 have been withdrawn from further consideration. Claims 13-19 have been cancelled in this Response. No new claims have been added.

(1) Claims 2-5 were objected to as being of improper dependent form for failing to further limit the subject matter of the previous claim.

Claims 2-5 have been amended to make it clear that the scope of amended claims 2-5 further limit the previous claim. Reconsideration of the objection is respectfully requested.

(2) Claims 5 and 6 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

Claims 5 and 6 have been amended. Contrary to the examiner's statement, the term "cyclic olefin" *per se* contains an internal alkenyl group, because an "olefin" is an unsaturated hydrocarbon compound. Reconsideration of the rejection is respectfully requested.

(3) Claims 1-4 and 8-12 were rejected under 35 U.S.C. §102(a)/102(e) as being anticipated by Matyjaszewski et al (U.S. 5,763,548).

Applicants traverse the rejection because the compound disclosed at col.8, lines 45-50, as

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referred to by the Office Acton, page 6, lines 12-15, is directed to an initiator. See col. 8, line 45.

Generally, an initiator is added before initiating polymerization. On the other hand, the compound (I) of the present invention is added during or at the end point of polymerization. Therefore, the rejection of claims 1-4 and 8-12 are not supported by Matyjaszewski et al. Reconsideration of the rejection is respectfully requested.

(4) Claims 13-18 were rejected under 35 U.S.C. §102(a, e, b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Matyjaszewski.

Claims 13-18 have been cancelled.

(5) Claims 1-4 were rejected under 35 U.S.C. §102(a) as being anticipated by WO 98/47931 or U.S. Patent 6,423,787.

Contrary to the examiner's statement, Formula (1) of the reference, even though R1 represents an ester group, merely shows the terminal structure of the polymer. The reference does not disclose the step of adding the compound as recited in claim 1 during polymerization or at the end point of the polymerization. Namely, Formula (1) of the reference, as asserted by the Office Action, is different from the compound as recited in claim 1. The rejection under 35 U.S.C. §102(a) is not supported by WO 98/47931 or U.S. Patent 6,423,787. Reconsideration of the rejection is respectfully requested.

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(6) In view of the above, claims 1-12, as herein amended, are in condition for allowance.

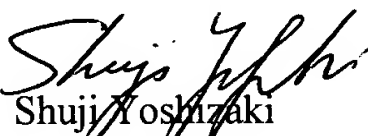
Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact the Limited Recognition at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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Limited Recognition

Attachment: Limited Recognition

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